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EXAMINER

BONZO, BRYCE P

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. DUNSTAN

Appeal 2008-1510
Application 10/644,628
Technology Center 2100

Decided: December 8, 2008

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III,
and THU A. DANG, *Administrative Patent Judges*.
COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to power management in computing devices. (Spec. p. 2, ll. 4-17).

Independent claim 1 is illustrative:

1. In an apparatus, a method of operation comprising:
 - receiving a state signal signaling whether the apparatus is in an AC failure state;
 - receiving a power button event signal signaling an event associated with a power button of the apparatus; and
 - negating the power button event signal if the state signal signals the apparatus is in the AC failure state.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the obviousness rejection:

Cooper	US 5,838,982	Nov. 17, 1998 (filed Dec. 19, 1996)
Westerinen	US 2004/0088589	May 6, 2004 (filed Mar. 6, 2003)

THE REJECTIONS

1. The Examiner rejected claims 1-30 under 35 U.S.C. § 112, first paragraph for failure to comply with the written description requirement.

2. The Examiner rejected claims 1-30 under 35 U.S.C. § 103(a), as being unpatentable over Westerinen in view of Cooper.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellant's Briefs to show error in the proffered prima facie case.

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

35 U.S.C. § 112, first paragraph

ISSUE

Has Appellant shown the Examiner erred in rejecting claims 1-30 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because the original disclosure included the term "ignored", which was replaced by the term "negated?"

PRINCIPLES OF LAW

35 U.S.C. §112, first paragraph

To satisfy the written description requirement, a patent Specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 1563. However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002). Much of the written description case law addresses whether the Specification as originally filed supports claims not originally in the application.

ANALYSIS

Appellant contends that the Examiner erred in rejecting claims 1-30 under § 112, first paragraph because the claims are supported in the original disclosure. The Examiner contends that Appellant has amended the claims to define “negated” and remove “ignored” from the Specification in an attempt to overcome the prior art. (Ans. 3).

Based on the record before us, we note that the independent claims under appeal are as originally filed and have not been amended. Thus, these claims were not amended as alleged by the Examiner. Further, we note that the Specification includes the original claims as filed:

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, (Fed. Cir. 1985). (underline added).

Because the originally filed independent claims recite “negate” or “negating” (e.g., negating a power button event signal or device wake event signal), Appellant may amend the Specification to include the claimed subject matter. Accordingly, we find that Appellant did in fact, have possession of the present invention at the time the application was filed.

Thus, we reverse the Examiner’s rejection of claims 1-30 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

Obviousness under 35 U.S.C. § 103

We consider the Examiner’s rejection of claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over Westerinen in view of Cooper. Since Appellant’s arguments have treated these claims as a single group which stand or fall together, we select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Has Appellant shown the Examiner erred in determining that Cooper teaches the limitation of negating the power button event signal and that there was motivation to modify Westerinen to achieve the method of claim 1?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Westerinen

1. Westerinen is directed to preserving user and system state data in the event of an AC power failure. (Abst. ll. 1-3).
2. Westerinen teaches special handling of the state signal in the event that AC power is off or becomes unstable. (Para. 30).
3. Westerinen does not explicitly teach negating a power button event signal.

Cooper

4. Cooper is directed to power switch management for a computer. (Abst. ll. 1-2).
5. Cooper teaches a determination of whether the power switch is activated. (Col. 3 ll. 37-39)

6. Cooper teaches that even if the power switch is activated, system power is off if there is no available system power. (Fig. 2, refs. 106 – 114).

ANALYSIS

Claim Construction

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

In the present case, we broadly but reasonably construe the claimed “negating the power button event signal” as to make the power button event signal ineffective or invalid. This construction is consistent with Appellant’s original disclosure as evidenced by Appellant’s replacement of “ignoring” with “negating” and is also consistent with the plain meaning of the term (claim 1).

As discussed above, Westerinen teaches special handling of the state signal in the event that AC power is off or becomes unstable. As shown in Fig. 2 of Cooper, if the power button is pressed down, (ref. 106), and the system does not have an available power source (ref. 108-112), the effect of the power switch being pressed down is in fact negated. Thus, Cooper teaches that power button is “negated” i.e., ineffective, if the power button is pressed.

Based on the record before us, it is our view that Cooper, in combination with the teaching of Westerinen discussed *supra*, teaches making the power button ineffective if the state signal signals that the

apparatus is in the AC failure state, this teaching meeting the limitation “negating the power button,” as recited in claim 1.

With regards to Appellant's argument that there is no motivation to modify Westerinen to achieve the method of claim 1, we note that Westerinen does not disavow or teach away from such a modification.

“[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Thus, we find Appellant’s argument that there is no motivation to modify Westerinen to achieve the method of claim 1 to be unpersuasive.

Based on the record before us, we conclude that Appellant did not meet his burden of showing error in the Examiner’s prima facie case of obviousness. Accordingly, we sustain the rejection of claim 1, and claims 2-30 which fall therewith, as being unpatentable under 35 U.S.C. § 103(a) over Westerinen and Cooper.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

The Examiner erred in determining that the claimed element “negating the power button event signal” failed to comply with the written description requirement.

Based on the findings of facts and analysis above, we conclude that Appellant has met his burden of showing that the Examiner erred in

rejecting claims 1-30 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

The Examiner did not err in determining that Cooper teaches the claimed element “negating the power button event signal.”

Based on the findings of facts and analysis above, we conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 1-30 as being unpatentable over Westerinen in view of Cooper under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner rejecting claims 1-30 under 35 U.S.C. § 112, first paragraph is reversed.

The decision of the Examiner rejecting claims 1-30 under 35 U.S.C. § 103(a) is affirmed.

Because we have sustained at least one rejection for each claim on appeal, we affirm the Examiner’s decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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